

REPLY TO OFFICE ACTION
DATED MARCH 18, 2008

Appln. No. 10/541,170

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REMARKS

This is in reply to the Office Action dated March 18, 2008.
Reconsideration is respectfully requested.

Priority Claim

Applicant is filing a certified copy of the foreign priority document under separate cover simultaneously with this filing for perfection of priority claim.

Status of Claims

Claims 21-34, 36, 37, 39 and 41-48 are pending and all are rejected. Claims 21-24, 26-33, 36, 37, 39 and 42-48 are rejected as obvious over any one of British Patent No. 373,477 to Reid, U.S. Patent No. 7,052,021 to Plottnik and U.S. Patent Application Publication No. 2004/0049989 to Florentin et al. Claims 25, 34 and 41 are rejected as obvious over either Plottnik or Reid.

Summary of Rejections as to Indefiniteness

Claims 21-34, 35, 37, 39 and 41-48 are rejected as indefinite, the Examiner finding uncertainty with phrases such as "independently mountable" and "adjustably positionable" and "adjustably connectable". The Examiner further notes that "contact between sealing lip and window pane is not possible without a positive connection of the shaped parts and the frame structure".

Applicant has addressed the Examiner's concerns with the amendments to Claim 21, which positively recite the mounting and positioning of the shaped parts on the frame structure to ensure that contact between the various parts is possible. Applicant respectfully

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disputes the notion that the claims are "functional", as there is ample structure, positively recited, clearly shown in the drawings and described in the specification, such that one of ordinary skill in the art would understand how to make and use the invention. Any perceived functional aspects provide depth to the claim and should not be singled out or emphasized to the exclusion of the structural recitations.

Objections to Drawings

The Examiner has objected to the drawings, noting claim recitations "independently mounted", "adjustably positionable" (Claim 21), "releasably connected" (Claims 41 and 42), and states that these features must be shown or canceled from the claims. To this end, applicant provides herewith additional Figure 4, which shows a portion of Figure 2 on an enlarged scale. Figure 4 shows shaped part 2 mounted on inner wall 3' of frame structure 3 as described on page 9, lines 15-18. The mounting is effected by a screw fastener as noted in the description. Consistent with this description, a screw 32 has been added at location 10 (note that 10 is described consistently as a location throughout the specification). Shaped part 1 is attached to edge portion 6 of inner wall 3' independently of part 2 by a different screw 20. This is described in detail on page 10, lines 21-36. The adjustable aspect of part 1 is illustrated in Figure 4 by the elongate slot 30, consistent with the description on page 11, lines 9-13. The slot extends in the direction of arrows 21 so as to permit adjustability of part 1 perpendicular to the window 17 (see also Figure 2). With respect to the releasable connection of members 1 and 2 as recited in Claims 41 and 42, it is noted that the use of screw fasteners as described above, renders the parts releasably connected to the frame structure.

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In response to the Examiner's remark that "line 10 is not even suggestive of any type of mounting", applicant notes that reference character 10 denotes a location, as described in the specification on page 9, line 18 and page 11, line 7. As such, the line segment provides an adequate representation of a location, for example, where a screw might be positioned to effect mounting of part 2 to part 3. Applicant contends that one of ordinary skill in the art would have no problem constructing this arrangement in view of the description and drawings provided.

Applicant resubmits Figure 2, providing a lead line to reference character 24 in view of the Examiner's objection. Reference character 24 refers to the outer face of the side part 14 as noted on page 12, lines 16-21.

Applicants have further amended the specification at pages 8, 9 and 11 consistent with the addition of Figure 4 as provided above. No new matter has been added.

Traversal of Claim Rejections as to Obviousness

Applicant respectfully traverses the rejection of the pending claims, contending that the cited references fail to meet the requirements necessary to establish a *prima facie* case of obviousness. Applicant's position is explained in detail in the arguments presented below.

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Claim 21

Claim 21 is drawn to a sealing strip mountable on a frame structure of a vehicle for sealing a window, and recites, in relevant part:

"first and second shaped parts, each mounted independently of one another on said frame structure...

at least one sealing lip mounted on one of said first and second shaped parts...

wherein at least one of said first and second shaped parts on which said sealing lip is mounted is adjustably positioned relative to said frame structure, said one shaped part being movable relative to said frame structure substantially perpendicular to said window pane..." (Emphasis added.)

Applicant notes, in particular, the recitation that one of the shaped parts is adjustably positioned and movable relative to the frame structure. Such an adjustable, movable structure is not taught or suggested in any of the cited references. In fact, the prior art cited exhibit precisely the behavior that the invention is intended to overcome. First, there is no express teaching of adjustability of parts mounting a sealing lip in any of the cited references. The Examiner has not cited any direct description of such a configuration because it is not present. A review of Figures 1-5 in Reid shows seals, such as 18 and 19 being held in place by clips 21 and 23, or merely wedged into a space. There are no adjustable features for the seals in this reference. Similarly, Plotnik illustrates sealing elements 22 and 24 clipped to structural components 10, 12 and 39, with no provision made for adjustability. Florentin et al is consistent with sealing members 31 and 61 clipped to structural elements 1' and 50, respectively, with no adjustability toward or away from pane 7.

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The Examiner contends that each reference discloses shaped parts which are adjustably positionable via "shims, bending of the mounting flange 8/10 and insertion depth of the carrier 600 respectively". However, applicant notes that shims are impractical for use in an automotive environment where constant vibration and the repeated motion of the window against the sealing strip require a positive mounting not possible using shims. The application of common sense would not lead one to use shims as suggested by the Examiner. Likewise, adjusting the insertion depth of the carrier 600 suffers the same problems, as there is no suggestion as to how the insertion depth would be maintained. Bending of the mounting flange is equally untenable as a suggested method of adjustment when it is noted that Claim 21 recites that the shaped part on which the sealing lip is mounted is "adjustably positioned relative to said frame structure, said one shaped part being movable relative to said frame structure" (emphasis added). Moving the frame structure itself is not what is recited in the claims, it is the adjustable movement of the shaped parts relative to the frame which is recited. Furthermore, the Examiner's solution of bending a metal flange to adjust the position of a window seal cannot be taken seriously. It is clearly a desperate attempt to support a conclusion of obviousness without a practical engineering foundation.

Furthermore, Claim 21 recites that the first and second shaped parts are in spaced relation and delimit a space "with a generally U-shaped cross section". Neither Plottnik nor Florentin et al disclose "first and second shaped parts, each mounted independently of one another on said frame structure...and delimiting a space with a generally U-shaped cross section", as recited in Claim 21.

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In view of the arguments presented above, applicant contends that the cited references fail to teach or suggest all claim limitations and therefore do not meet the requirements necessary to establish a *prima facie* case of obviousness. Applicant, therefore, requests that the rejection of Claim 21 be withdrawn.

Remaining pending Claims 22-34, 36, 37, 39 and 41-48 depend, either directly or indirectly, on Claim 21 and should be allowable over the cited references for the same reasons that Claim 21 is allowable.

Claims 25, 34 and 41 are rejected as obvious over Plottnik or Reid, the Examiner contending that the sealing structures disclosed therein are adjustable via bending of the flange or using shims. Applicant notes that the references themselves do not teach adjustability, and again dispute the Examiner's assertion that shims or bending would be viable means for adjustment as noted in the arguments presented above.

Summary

Applicant has demonstrated, in the arguments presented above, that the cited references fail to meet the requirements necessary to establish a *prima facie* case of obviousness because all claim limitations are not taught or suggested. Applicant contends that the claims are

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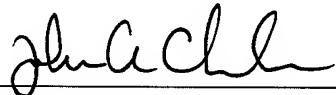
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allowable and requests that the rejections be withdrawn and the application passed to issue.

Respectfully submitted,

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